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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,261	02/12/2004	Craig Marshall Darsow	ROC920030338US1	5407
46296	7590	08/18/2006	EXAMINER	
MARTIN & ASSOCIATES, LLC P.O. BOX 548 CARTHAGE, MO 64836-0548			DINH, PAUL	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/777,261

Applicant(s)

DARSOW ET AL.

Examiner

Paul Dinh

Art Unit

2825

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 15-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/12/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is a response to the election filed on 8/2/06

Claims 1-8 and 15-25 are pending.

#### ***Specification***

The specification is objected to because the blank spaces in page 1 of the specification must be filled/updated with current information (of related application(s)) and Patent number(s) if patented. Correction is required.

#### ***Claim Rejections - 35 USC § 101***

*35 U.S.C. 101 reads as follows:*

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain patent therefor, subject to the conditions and requirements of this title.*

Claims 15 and 21 are rejected under 35 U.S.C. 101 because "A program product" does not meet utility requirement; i.e., A computer readable program product" will meet utility requirement

#### **Claim Rejections - 35 USC § 112**

*The following is a quotation of the second paragraph of 35 U.S.C. 112:*

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.*

Claims 15-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15, 21 (and their dependencies) are rejected because the limitation "signal" in "computer readable signal bearing media bearing the timing analysis mechanism" is unclear as to what signal the applicant means.

In claims 17 and 23; "transmission media" as presented is unclear and misleading to a transmitting circuit/transmitter.

Art Unit: 2825

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

In claims 15 and 21; "the plurality of slack computations" lacks antecedent basis.

In claim 18, "the static timing tool" lacks antecedent basis.

In claims 19 and 25 "the slack" lacks antecedent basis. It appears the applicant means "the at least one slack computation"

Examiner suggestions:

1. "computer readable signal bearing media bearing the timing analysis mechanism" in claims 15 and 21 should be amended; i.e., "computer readable media storing a program to implement the timing analysis mechanism, the program enables a computer to execute the timing analysis mechanism" and then cancel claims 16-18 and 22-23 or simply
2. Replacing "computer readable signal bearing media" in claims 15 and 21 with "recordable media"; and then cancel claims 16-18 and 22-23.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application, see 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 and 15-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 14, 18-21, and 24-25 of copending Application No. 10/777,262.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in present application are similar to claims in co-pending application as shown.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Allowable Subject Matter***

Claim 1-8 and 15, 19-21, and 24-25 (Note claims 16-18 and 22-23 suggested canceled as above-mentioned) would be allowable if:

- a. The specification objection is overcome; and
- b. Rewritten to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action; and
- c. Rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action; and
- d. The double patenting issue is overcome.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Dinh whose telephone number is 571-272-1890. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Jack Chiang can be reached on 571-272-7483. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2825

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PAUL DINH  
PRIMARY EXAMINER

A handwritten signature in black ink, reading "Paul Dinh", with a long horizontal flourish extending to the right.